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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/330,651	06/11/1999	CONNIE T. MARSHALL	ODS-5	9681

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EXAMINER	
CHRISTMAN, KATHLEEN M	
ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/330,651	Applicant(s) MARSHALL ET AL.	
	Examiner Kathleen M Christman	Art Unit 3713	

-- Th MAILING DATE of this communication appears on th cover sh t with th correspondence address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

In response to amendment filed 01/24/2002, claims 1-30 are pending in this application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-13 and 26-28 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. The structural limitations of the claim cannot perform the function of an "interactive wager system" or the method for "interactive wagering". This is evident that within a wagering system the user must be capable of placing a wager. The term "participant options" is not directed to options that would require the user to place a wager, in fact the limitations of the dependent claims state that a participant option is a horse or a jockey.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 10 and 25are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO/97/09699 to ODS Technologies, herein after '699. With regards to claims 10 and 25, '699 discloses a system and method for displaying an interactive wagering system in which the system receives user inputs and presents a series of displays each corresponding to a plurality of user selection requirements, wherein each display has a series of options that corresponds to the options for the user selection requirements, an option can be designated as the selected option, and a "simulated wager ticket" is displayed. Figures 35-39 in particular show this method as it progresses through each screen. The "simulated wager ticket" as claimed by applicant is merely a summarization of the bet that the user is placing and is shown in Figure 39, and is described on page 25 line 21 through page 26 line 22. This section of txt also describes the ability to highlight an option that is selected. With regard to the simultaneous display of the wager ticket versus the end result view of the ticket, it is clearly a matter of design preference as to which a designer would use. There is no patentable difference in the two designs.

5. Claims 15 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al (US 6068552). Walker et al discloses a wager system and method, and in the form of a slot amchine, in which user inputs are received, the user selects wager options (payout schedule, probability, and wager amount), places a wager (uses the machine for one round), and where the wager options are the default selections in subsequent wager entry processes, wherein wagering options other than the default wager options are available for selection in a subsequent wager entry. Once the user sets the options for the

machine they are the defined options on the machine, however the user may alter the options at any point. See Figures 1-9B.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. **Claims 1-4 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Massaro et al (US 5535321).** The invention is drawn to a method and system for interactive wagering comprising the steps of, receiving user inputs; presenting one of an expert wager input interface and a novice wager input interface based upon user inputs; interpreting the user inputs as specifically selecting the type of input wager interface (claims 2 and 17); switching from one interface to another interface (claims 3 and 18); and transferring wager selection information from one interface to another (claims 4 and 19). Massaro et al discloses a method and system for displaying an interface in which the user inputs the type of interface that is desired and is presented with that interface. The interfaces are differentiated by their level of difficulty, particularly "basic", "intermediate", and "advanced". It is well understood that one of ordinary skill in the art would understand that a "basic" and "advanced" are synonymous with "novice" and "expert" and removing the third "intermediate" level would be easily engineered. Col. 5: 30-57 describes the ability for a user to change the type of interface that is being presented. Additionally, it is taught in the above-cited area that the "override" feature may be invoked at any point in the process, this would include after the beginning of an interaction sequence. The ability to transfer information between various electronic forms is old and well known in the art. It would obvious to one of ordinary skill in the art to include this feature in the invention of Massaro et al so that a user of the system would not "lose" any work that has been completed in the system. The examiner notes that the invention of Massaro is not directed to a wagering system or wagering interfaces per say. However, it is disclosed that the system is meant to be used in any computer based interface system. See the entire disclosure, in particular the abstract, col. 1: 27-36, col. 2: 6-13, col. 2:62-67, col. 3: 38-46, col. 4: 2-12, col. 4 37-41, and col. 6: 15-25.

10. **Claims 5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prather et al (US 5823872).** Prather et al discloses a system and method for placing a wager in which, user inputs are received, a wager input interface is displayed having a plurality of user selection requirements and a plurality of options for each of the plurality of user selection requirements, wherein the plurality of user selection requirements are aligned in a first dimension, and wherein the plurality of options are displayed

such that they are aligned substantially in a second dimension with the one of the plurality of user selection requirements, see Figure 8. In the instance of Figure 8, the horses' names are the user selection requirements, and win, place, and show are the options. Prather et al does not teach a plurality of selection requirements. However, in the description of the "Gimmicks" button Prather clearly shows the use of a plurality of selection requirements. For example, the selection options are Quinella, Exacta, and Trifecta, each of which has a plurality of options namely horse's names that correspond thereto. Given this it would have been obvious to one of ordinary skill in the art to organize these bets in the same layout as that shown in Figure 8 for selection requirement.

11. **Claims 6-9 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of WO/9709699 and Prather et al (US 5823872).** '699 teaches a system and method for interactive wagering that includes the user selection requirements of track selection, race selection, wager type selection, horse selection, and amount selection (claims 6 and 21) in figures 35-38, user inputs being used to select at least one of the plurality of options for each of the user selection requirements (claims 7 and 22) also in the above figures, the selected option being highlighted (claims 8 and 23) on page 25 line 21+ and a ticket window that indicates each of the plurality of options selected (claims 9 and 24) in figure 39. '699 does not teach the specific lay out as claimed by applicant. Prather et al discloses this layout in Figure 8. It would have been obvious to one of ordinary skill in the art to modify the layout of the '699 publication with the layout as disclosed by Prather et al to allow for faster entry of wagering information. Additionally, the specific choice of layouts for an interface is a design choice and does not detract from the function or scope of an invention.

12. **Claims 14 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO/97/09699 to ODS Technologies, herein after '699 in view of Massaro et al (US 5535321).** The system and method of '699 discloses the process of receiving user inputs, in response to receipt of one of the user inputs selecting a set of menu options that are a function of the current operating mode; and presenting a menu containing the set of menu options. The '699 specification discloses the ability for a

user to enter two modes of operation while the user is operating it. The modes of operation are best shown in figure 3, wherein the user at step 172 may select a "view race track" mode an "account information" mode a "news and information" mode or a "bet on next race" mode. The user selection will then determine which information and menu options are displayed to the user. This is shown in the subsequent figures. The '699 publication does not show the options of providing one of an expert and novice interface. Massaro et al clearly shows this as discussed above in the rejection of claims 1 and 16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the different wager interface types to the system of the '699 publication in order to allow a user to more comfortably place a bet.

Response to Arguments

13. Applicant's arguments filed 01/14/2002 have been fully considered but they are not persuasive.

Claims 1-4 and 16-19

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Massaro et al clearly states at col. 1: 27, "One example of a known solution to this problem is exhibited in many game and entertainment applications in which a user may select a 'beginner', 'intermediate', or 'expert' level of play, wherein the speed, complexity, and skill level of a selected game may be permanently altered for the duration of an entire game sequence". This clearly shows that this type of system in known to be applicable in

entertainment applications. Gambling is a well-known and accepted form of entertainment. In essence this citation describes the whole of applicant's claims 1 and 2.

Claims 5-9 and 20-24

The examiner has shown where Prather et al teaches a plurality of types of user selection requirements in the rejection of paragraph 7. The arguments, concerning claims 6-9 and 21-24, do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Claims 11-13 and 26-28

The ability for a user to merely select a horse or jockey does not allow a user to place a wager. It is well-known that placing a wager requires that a user must choose at the least a horse, a position, and a wager amount. There is nothing in the structure of the claim that requires that these are the participant options. In fact the participant options could be the type of display the user desires to interact with.

The examiner believes all other arguments have been addresses, either in this section or in the paragraphs above.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Kathleen M. Christman
Patent Examiner
March 11, 2002

Joe H. Cheng
Primary Examiner